

648 (Fed.Cir. 1985); Carmen Indus., Inc. v. Wahl, 724 F.2d 932, 220 U.S.P.Q. 481 (Fed.Cir. 1983).

**a. The Proposed Claims Include Features Not Found In the Harvey '825 Claims**

The present claims included a number of features which are not recited in any of the Harvey '825 claims. In particular, the present claims recite "a switch means for receiving output from said plurality of receiver/distribution means, said switch means being capable of directing a selected portion of said programming . . . to an associated output device" (claim 1). The present claims further recite a "matrix switch means for receiving said programming from such a receiver/distributor means and for directing selected portions of said received programming to one or more output devices" (claim 3). None of the claims of the Harvey '825 patent recite a switch means or a matrix switch means. The Harvey '825 claims do not claim any method of data communication using a switch means.<sup>1</sup> Nothing claimed in the Harvey '825 patent performs the function of the switch set forth in the present claims.

The present claims also recite "a plurality of receiver/distribution means for receiving programming from a program source and for inputting said program to a switch means and a plurality of detector means" (claim 1). The Harvey '825 claim does not recite a plurality of receiver/distribution means as recited in the present claims.<sup>2</sup> Applicants submit that these and other differences render the present claims patentably distinct from the Harvey '825 claims.

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<sup>1</sup> Of the 26 claims included in the present application, 17 specify either a switch means or a matrix switch means, and 3 more specify a method of data communication in a system that includes a switch (see e.g., claim 19).

<sup>2</sup> Harvey '825 does claim, in a signal processor system, "carrier transmission receiving means" (claim 1). However, this element performs a very different function than the receiver/distribution means of the present claims.

**b. The Examiner Has Not Established a Prima Facie Case Sufficient to Support a Rejection for Obviousness-Type Double Patenting**

As with any rejection on art, the PTO has the burden of establishing a prima facie case of obviousness-type double patenting. In re Bratt, 937 F.2d 589, 592-3, 19 U.S.P.Q.2d 1289, 1292 (Fed.Cir. 1991); compare, In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). The analysis for an obviousness-type double patenting rejection is analogous to, but identical to, that for a rejection for obviousness under 35 U.S.C. § 103. Braat, supra, 937 F.2d at 592-3, 19 U.S.P.Q.2d at 1292; Longi, supra, 759 F.2d at 892 n.4, 225 U.S.P.Q. at 648 n.4.

However, the Federal Circuit has held that the decisional guidelines established for the Section 103 analysis are applicable to the double patenting analysis. Id. To have a proper basis for an obviousness-type double patenting rejection, the examiner must find all the features of the claims at issue in the prior issued claims or in some prior art reference. Longi, supra, 759 F.2d at 895-6, 225 U.S.P.Q. at 651. The examiner must then identify some objective teaching in the prior art, or knowledge generally available to one of ordinary skill in the art, which would lead that individual to combine the relevant teachings of the references with the features of the issued claims. Longi, supra, 759 F.2d at 896-7, 225 U.S.P.Q. at 651; Fine, supra, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In making a double patenting rejection, the examiner may properly consider and rely upon the prior art and the subject matter of issued claims of the parent application, but not the teachings of the parent's specification. In re Kaplan, 789 F.2d 1574, 1579, 229 U.S.P.Q.678, 682 (Fed. Cir. 1986). If the examiner fails to sustain his burden of establishing a prima facie case of obviousness, then the rejection will not stand and a patent

must issue. Id., 789 F.2d at 1580, 229 U.S.P.Q. at 683; see also Fine, supra, 837 F.2d at 1075, 5 U.S.P.Q.2d at 1599.

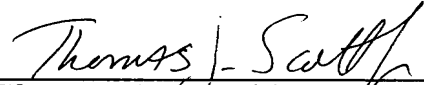
In the present case, clear differences exist between the proposed claims and the claims of the referenced Harvey '825 patent. (See Section a. above). The examiner has pointed to no reference disclosing those features of the pending claims not found in the issued claims of the Harvey '825 patent. Further, the examiner has cited no references or other evidence to support his conclusion that modification of the Harvey '825 claims to include the absent features would be obvious under the appropriate legal standard. Having failed to provide such evidence, the examiner has not met his burden of establishing a prima facie case of obviousness-type double patenting. Therefore, the rejection of the present claims on obviousness-type double patenting cannot stand.

#### CONCLUSION

Applicants respectfully request that the examiner withdraws his double patenting rejection. Early issuance of a notice of allowance is requested.

Respectfully submitted,

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